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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,598	06/25/2003	Hideharu Takeshima	239480US0DIV	1461
22850	7590	04/22/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER MILLER, BRIAN E	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/602,598

**Applicant(s)**

TAKESHIMA ET AL.

**Examiner**

Brian E. Miller

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-9 and 17-24 is/are pending in the application.  
4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 5-9 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 5-9 and 17-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/842,139.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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This is a CON of 09/842,139 and claims 5-9, 17-24 are pending.

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/842,139, filed on 4/26/01.

***Election/Restrictions***

2. Applicant's election with traverse of species (2) in the reply filed on 12/6/04 is acknowledged. The traversal is on the ground(s) that the Examiner has not carried the burden of providing any reasons and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct. This is not found persuasive because applicant's own disclosure sets forth patentable distinction. On page 19, lines 19+, it is set forth that "One method of forming such a pattern on the print-receiving layer is to form the pattern by convexes or concaves." Additionally, on page 21, lines 15+, it is set forth that "Another method of forming a pattern on the print-receiving layer is to form a pattern on the print-receiving layers by colors..." This is considered to encompass at least different species.

As set forth in the restriction requirement, should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the

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other invention. Applicant has not made such statements and/or provided the aforementioned evidence, therefore, the requirement is still deemed proper and is therefore made FINAL.

3. Claims 18-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 12/6/04.

### *Drawings*

4. The drawings are objected to because: (a) the amended and/or new drawings submitted in the parent application 09/842,139, have not been provided herein; (b) the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “the print-receiving layer has a pattern of concaves, convexes or a combination thereof,” as recited in claims 5 & 8, and “a second layer in contact with the print-receiving layer, wherein the second layer has a pattern of concaves, convexes or a combination thereof...”, as recited in claim 9, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. It is noted that applicant’s priority document 2000-189192 appears to include such figures, however.

(c) The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

#### **Arrangement of the Specification**

a. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT

(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), “Sequence Listings” (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

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REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).  
"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

- b. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 5-9, 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (a) claim 5 recites "the print-receiving layer has a pattern of concaves, convexes, or a combination thereof..." This constitutes new matter, since only the embodiment of having *both* convexes and concaves has been described previously in the specification. There is no disclosure of having either, i.e., not both, convexes and concaves in a print-receiving pattern;

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(b) with respect to claim 9, there is no disclosure of a “second layer in contact with the print-receiving layer, wherein the second layer has a pattern of concaves, convexes or a combination thereof...” Only one layer has been disclosed with such a layer configuration.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-9, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (a) Claim 5, recites “has a pattern of concaves, convexes, or a combination thereof” which is considered misdescriptive. If only “convexes” or “concaves” are present, it is not readily apparent how a contrasting pattern would result and therefore a “pattern” *per se*, would not be present. It would appear that only a situation where both convexes and concaves are present would a contrasting pattern exist; (b) claim 5 (and similarly for claim 8), last line the language “the pattern of concaves and convexes is present” is indefinite for the reason set forth in item (a), above.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 5-9, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujio (2000-57635). In so far as the claims are definite, clear and understood, (as per claim 5) Fujio et al discloses an optical recording medium suitable for printing pattern characteristics including a print receiving layer (printing acceptance layer); wherein the print receiving layer is printable with a water base ink (re claims 6 & 7-see paragraph [0017]; wherein the mean particle diameter is 200nm or less (re claim 7-see paragraph [0020]); wherein the fine particles comprise between 30%-50% of weight of an inorganic substance (re claim 17-see paragraph [0021] (the recited range falls within the disclosure of Fujio). Furthermore, with respect to claim 7 and the pattern comprising a cation resin as well, Fujio et al discloses that due to a capillary action of the print-receiving layer, the pattern will also include some of the cation resin after drying (see [0015] lines 3-7).

Further, with respect to claim 6, the language “wherein the print-receiving layer is *printable with a water base ink by means of an ink jet printer*” (emphasis added by Examiner) is considered to be met by Fujio et al, since the cited language is considered to encompass intended use and as such, does not constitute a positive recitation of structure. Fujio et al’s “pattern” as shown in the figure is considered to have the “capability of being printed thereon”, as required by the claim.



With respect to claim 5, Fujio is expressly silent as to the pattern including convexes and concaves, however, in so far as the structure of these convexes and/or concaves have been positively set forth in the claims/specification, while the figure in Fujio generically shows a “pattern” 3, it would have been readily apparent to a skilled artisan that *any* printable pattern would be within the knowledge of a skilled artisan, which would include both convexes and concaves. For example, the different areas of Fujio 1, 2, 3 (see FIG. 1) could constitute a difference in height, which could encompass the claims “convexes” and/or “concave” areas. Furthermore, it has been held that a change in form/shape/size of an object, i.e., a “pattern” in this case, lacking any unobvious or unexpected results, would have been within the knowledge of a skilled artisan; see *In re Rose*, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 149 USPQ 47 (CCPA 1976), regarding these matters.

With respect to claim 8, having a difference of heights of the concaves and convexes being “at least 0.1 um, would have resulted through routine experimentation/optimization of a skilled artisan, so that the pattern would be properly visible, would have been obvious thereto.

With respect to claim 9 and having a “second layer” having concaves and/or convexes, providing such to the layer structure of Fujio would have been obvious to a skilled artisan, as it would have encompassed a mere duplication of “parts”, e.g., layers, to thereby enhance the appearance thereof. See also *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7<sup>th</sup> Cir 1977), regarding duplication of “parts”.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (571) 272-7578. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Brian E. Miller**  
**Primary Examiner**  
**Art Unit 2652**

BEM  
April 18, 2005